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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,325	07/10/2003	Fredrik Stenmark	9342-100	2825
54414	7590	04/11/2007	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC, P.A. P.O. BOX 37428 RALEIGH, NC 27627			DAO, MINH D	
		ART UNIT	PAPER NUMBER	
		2618		
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	04/11/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/617,325	STENMARK, FREDRIK
	Examiner MINH D. DAO	Art Unit 2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01/31/07.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-38 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 01/31/07 have been fully considered but they are not persuasive.

Regarding the 35 U.S.C. 112 rejections of claims 1,29 and 31, the rejections are clarified as indicated below.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 recites the limitation "from/to an electronic device" in line 3. There is insufficient antecedent basis for this limitation in the claim. The above quoted phrase should be corrected such as "from/to **the** electronic device".

4. Claim 29 recites the limitation "memory of an electronic device" in line 3. There is insufficient antecedent basis for this limitation in the claim. The above quoted phrase should be corrected such as "memory of **the** electronic device".

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5. Claim 31 recites the limitation "an electronic device" in lines 5 and 6. There is insufficient antecedent basis for this limitation in the claim. The above quoted phrase should be corrected such as "**the** electronic device".

6. In response to applicant's remark on page that the recitation of "absent from" refers to the fact that information used by the radiotelephone to register the radiotelephone with the network is absent from the radiotelephone. This limitation is not recited in any of independent claims 1,15,29,31, and 32. The independent claims 1,15,29,31, and 32 are rejected being interpreted that the electronic device transferring data to the wireless network when the **SIM is absent** not the **information used by the radiotelephone to register the radiotelephone with the network is absent**.

Therefore, independent claims 1,15,29,31, and 32 remain rejected for the above reason over Sterkel (US 6,907,264) in view of Cassidy et al. (US 6,480,725) as applicant admitted, page 11 of the remark, that the device of Sterkel register with the network when the service module 204 is absent. In addition, examiner only relies on Cassidy for the teaching of a SIM card that was not mentioned in Sterkel.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-38 rejected under 35 U.S.C. 103(a) as being unpatentable over Sterkel (US 6,907,264) in view of Cassidy et al. (US 6,480,725).

Regarding claim 1, Sterkel teaches a method of transferring data from/to an electronic device comprising: transferring data from/to an electronic device when a removable Enhanced Services Module having a Subscriber Identity Module (SIM) that stores information used to register the electronic device with a wireless communications network is absent from the electronic device (see figs. 1-4; col. 6, lines 47-55). However, Sterkel does not mention that the Enhanced Services Module is a SIM. Cassidy, in an analogous art, teaches a cellular phone having a module receiver that receives SIM card and detects at power up of the cellular phone the presence of the SIM card in order to go to ready-to-use conventional mode of the phone (i.e. transferring voice or digital information to its destination) (see figs. 1-3; col. 4, line 15 to col. 6, line 40). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the above teaching of Cassidy to Sterkel in order for the combined system to be able to have two options to connect to the cellular networks. The connection with the network through a SIM card is capable of informing the network of subscriber profiles such as repetary dialing information and function control information (see Cassidy, col. 4, lines 40-57).

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Regarding claim 2, the combination of Sterkel and Cassidy teaches a method according to claim 1 further comprising: determining that the SIM is absent from the electronic device; and determining if a transfer mode is enabled to allow transferring data while the SIM is absent from the electronic device (see figs. 1-4; col. 6, lines 47-55). In this case, the basic telephone functions of Sterkel inherently includes determining if a transfer mode is enabled to allow transferring data while the SIM is absent from the electronic device from/to its destination when the user activates the device to communicate with his/her destination, therefore the basic telephone functions of Sterkel read on the determining if a transfer mode is enabled to allow transferring data while the SIM is absent from the electronic device of the present invention. Also see figs. 1-3; col. 4, line 15 to col. 6, line 40 of Cassidy

Regarding claim 3, the combination of Sterkel and Cassidy teaches the method according to Claim 2 further comprising: transferring data if the transfer mode is enabled and blocking transferring data if the transfer mode is disabled. Sterkel teaches such limitation as the user, during the time when the SIM is absent, decides to use the phone or not.

Regarding claim 4, the combination of Sterkel and Cassidy teaches a method according to Claim 2 wherein the step of determining if a transfer mode is enabled comprises: requesting input to the electronic device; receiving input to the electronic device via an input device associated with the electronic device; and determining if the

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received input enables transfer mode. See the reasons for rejecting of claims 1-3 above.

Regarding claim 5, the combination of Sterkel and Cassidy teaches inherently the step of transferring comprises transferring the data using a first communications channel that is separate from a second communications channel used to register the electronic device with the communications network as it is a principle of cellular communication that the transferring or sending of data and the registration of the device with a network are done by two different channels that are the voice and the control channels of the communication network.

Regarding claim 6, the combination of Sterkel and Cassidy teaches the first communications channel is carried over at least one of an infrared communications link, a Bluetooth communications link, a USB interface, and an IEEE 802.11 communications link (see Sterkel, col. 8, lines 38-60).

Regarding claim 7, the combination of Sterkel and Cassidy teaches the electronic device comprises a mobile cellular radiotelephone configured to register in a Global System for Mobile telecommunications compliant communications network (see Sterkel, col. 3, lines 45-52).

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Regarding claim 8, the claim includes the limitation as that of claim 2, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 2.

Regarding claim 9, the combination of Sterkel and Cassidy teaches a method according to Claim 8 wherein a second SIM that stores information used to register the second electronic device with the communications network is absent from the second electronic device while transferring data. It is obvious that a combined system of Sterkel and Cassidy can be used at two ends of a communication link as described in Sterkel and Cassidy.

Regarding claim 10, the combination of Sterkel and Cassidy teaches transferring the data while a SIM that stores information other than that used to register the electronic device with the communications network is present in the electronic device (see Sterkel, col. 6, lines 47-55).

Regarding claim 11, the combination of Sterkel and Cassidy teaches the data comprises data stored in non-volatile memory of the electronic device (see Sterkel, fig. 2, processor 214 of phone 202).

Regarding claim 12, the combination of Sterkel and Cassidy teaches the data comprises at least one of contact information, schedule information, to-do information,

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e-mail information, web information, image information, audio information, and video information (see Sterkel, col. 7, lines 24-45).

Regarding claim 13, the combination of Sterkel and Cassidy inherently teaches that the data comprises excess data having a size that exceeds an unused storage capacity of the SIM because there must be cases where the amount of data that the phone of Sterkel would transfer or exchange with its destination is larger than the unused storage of the SIM card.

Regarding claim 14, the combination of Sterkel and Cassidy teaches the electronic device comprises a unitary mobile cellular radiotelephone (see fig. 2 of Sterkel, item 202).

Regarding claim 15, the claim includes the limitation as that of claim 1, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 1. In addition, the phone 202 of Sterkel also includes a processor 214 to perform the data transferring.

Regarding claim 16, the combination of Sterkel and Cassidy teaches the processor circuit is configured to determine whether the SIM is present or absent from the electronic device, the electronic device further comprising: a registration circuit configured to register the electronic device with the communications network responsive

to the processor circuit determining that the SIM is present; and a data transfer circuit configured to transfer data from/to the electronic device responsive to the processor circuit determining that the SIM is absent and a transfer mode is enabled to allow transferring data while the SIM is absent (see Sterkel, col. 6, lines 47-55; also see reasons for rejections of claims 1-3 above.).

Regarding claim 17, the claim includes the limitation as that of claims 1, and 3, therefore is interpreted and rejected for the same reason set forth in the rejection of claims 2 and 3.

Regarding claim 18, the claim includes the limitation as that of claim 4, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 4.

Regarding claim 19, the claim includes the limitation as that of claim 5, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 5.

Regarding claim 20, the claim includes the limitation as that of claim 6, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 6.

Regarding claim 21, the claim includes the limitation as that of claim 7, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 7.

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Regarding claim 22, the claim includes the limitation as that of claim 8, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 8.

Regarding claim 23, the claim includes the limitation as that of claim 9, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 9.

Regarding claim 24, the claim includes the limitation as that of claim 10, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 10.

Regarding claim 25, the claim includes the limitation as that of claim 11, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 11.

Regarding claim 26, the claim includes the limitation as that of claim 12, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 12.

Regarding claim 27, the claim includes the limitation as that of claim 13, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 13.

Regarding claim 28, the claim includes the limitation as that of claim 14, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 14.

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Regarding claim 29, the claim includes the limitation as that of claim 15, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 15.

Regarding claim 30, the combination of Sterkel and Cassidy teaches the user selectable data comprises at least one of audio information transferred to headphones coupled to the electronic device and video or image data transferred to a display of the electronic device that is selected by a user. The basic telephone data transferring functions of Sterkel reads on this limitation on the present invention.

Regarding claim 31, the claim includes the limitation as that of claim 29, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 29.

Regarding claim 32, the claim includes the limitation as that of claim 1, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 1.

Regarding claim 33, the claim includes the limitation as that of claim 8, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 8.

Regarding claim 34, the claim includes the limitation as that of claim 4, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 4.

Regarding claim 35, the claim includes the limitation as that of claim 5, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 5.

Regarding claim 36, the claim includes the limitation as that of claim 6, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 6.

Regarding claim 37, the claim includes the limitation as that of claim 7, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 7.

Regarding claim 38, the claim includes the limitation as that of claim 9, and therefore is interpreted and rejected for the same reason set forth in the rejection of claim 9.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH D. DAO whose telephone number is 571-272-7851. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MATTHEW ANDERSON can be reached on 571-272-4177. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Minh Dao  
AU 2618  
April 06, 2007

Matthew Anderson  
Supervisor AU 2618

